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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,124	11/16/2001	Anthony DiSalvo	PPC-813	5212
27777	7590	07/26/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			KIDWELL, MICHELE M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,124

Applicant(s)

DISALVO ET AL.

Examiner

Michele Kidwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6 and 16-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>012902; 112002; 012103</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 1 – 15 in the reply filed on April 7, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 16 – 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 7, 2004.

The applicant was further required to elect a species if the claims of group 1 were elected. In the reply filed April 7, 2004, the applicant elected the species corresponding to a bent configuration. However, the applicant failed to identify which claims were readable on this species. The examiner considers claims 1 – 3, 5 and 7 – 14 to be readable on the elected species. Accordingly, claims 4 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 2, 5, 7 – 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bucalo (US 4,172,446).

With respect to claim 1, Bucalo discloses an absorbent device for insertion into a vaginal cavity (col. 4, lines 1 – 2), the absorbent device comprising an absorbent body (22) and an indicator structure arranged and configured within the absorbent body, the indicator structure comprising a resilient member having a first arm (left side of 26) having a rough surface (col. 4, line 18) and a second arm (right side of 26), the first and second arms being maintained in a strained configuration by a restraint (28) wherein the restraint weakens upon exposure to moisture (col. 3, lines 48 – 60) and the resilient member is capable of articulating to a relaxed configuration upon the weakening of the restraint in a movement in which the rough surface of the first arm traverses the second arm to generate vibration discernable to the user.

The recitation of the intended use of the claimed invention (i.e. the resilient member being capable of performing a recited function) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 2, Bucalo discloses the absorbent body comprising absorbent material as set forth in col. 4, line 16.

With reference to claim 5, Bucalo discloses the resilient member (26) in a bent configuration as set forth in figure 2.

Regarding claim 7, Bucalo discloses the absorbent device wherein the first arm is maintained across the second arm as set forth in figure 2.

The examiner contends that the point at which the two arms meet (the right end of the structure) may be considered as the point at which the first arm is maintained across the second arm.

As to claim 8, Bucalo discloses the absorbent device wherein the first arm is maintained in a spaced relationship from the second arm as set forth in figure 2.

The examiner contends that the point that is adjacent to the point at which the two arms meet (the right end of the structure) may be considered as the point at which the first arm is maintained in a spaced relationship from the second arm.

With reference to claim 9, Bucalo discloses the absorbent device wherein the second arm has a rough surface as set forth in col. 4, line 18. Bucalo discloses that the first and second arms are constructed of elastic which may be considered a rough surface in comparison to the surface of feathers, paper, etc.

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As to claim 10, Bucalo discloses the absorbent device wherein the resilient member is formed of plastic, metals and combinations thereof as set forth in col. 6, line 21.

With respect to claim 11, Bucalo discloses the absorbent device wherein the restraint comprises a water soluble material as set forth in col. 3, lines 48 - 60.

Regarding claim 13, Bucalo discloses an indicator device comprising a resilient member having a rough surface and a second arm (26), the first and second arms being maintained in a strained configuration by a restraint (28) wherein the restraint weakens upon exposure to moisture (col. 3, lines 48 - 60) and the resilient member is capable of articulating to a relaxed configuration upon the weakening of the restraint in a movement in which the rough surface of the first arm traverses the second arm to generate vibration.

The recitation of the intended use of the claimed invention (i.e. the resilient member being capable of performing a recited function) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucalo (US 4,172,446).

The difference between Bucalo and claim 3 is the provision that the absorbent material is formed of fibers, foam or combinations thereof.

Bucalo discloses a slowly absorbent sleeve in col. 4, line 16.

Absent a critical teaching and/or show of unexpected results, the examiner contends that the claimed limitation is an obvious matter of design choice that does not patentably distinguish the claimed invention from the prior art.

The difference between Bucalo and claim 12 is the provision that the absorbent material is formed of fibers, foam or combinations thereof.

Bucalo discloses a slowly absorbent sleeve in col. 4, line 16.

Absent a critical teaching and/or show of unexpected results, the examiner contends that the claimed limitation is an obvious matter of design choice that does not patentably distinguish the claimed invention from the prior art.

Allowable Subject Matter

Claims 14 – 15 are allowed.

The following is an examiner's statement of reasons for allowance: the overall claimed combination of a method of absorbing aqueous vaginal fluids comprising the steps of inserting an absorbent device into a vaginal cavity wherein the absorbent device comprises an indicator structure having a first arm with a rough surface and a second arm wherein the rough surface of the first arm traverses the second arm to generate vibration discernable within the vaginal cavity and detecting the vibrations generated by the first arm traversing the second arm have neither been anticipated nor rendered obvious by the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michele Kidwell
Examiner
Art Unit 3761


JOHN D. CALVERT
SUPERVISORY PATENT EXAMINER
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